



Attorney Docket No.: FMS92302

#7/ Election
12-26-02
L. Spruell

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: Alexander C. Wall

Date: 12/10/2002

Serial No.: 09/671,804

Art Unit: 2854

Filed: 09/28/2000

Examiner: FUNK, STEPHEN R

For: METHODS FOR PROVIDING CUSTOM RUBBER STAMPS

Response to Restriction Requirement with Traverse

HONORABLE DIRECTOR OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

The following response is respectfully submitted.

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Election

On October 10, 2002, the examiner mailed a requirement to restrict stating that the claims were drawn to two patentably distinct species: a) a method of laser engraving a stamp and b) a method of exposing a photopolymer stamp. The examiner stated that applicant is required under 35 U.S.C. 121 to elect a single species for further prosecution.

Applicants provisionally elect species b), the photopolymer method.

Traversal

Applicants agree that, though not independent, the two species are patentably distinct. MPEP §803.01 states that 35 U.S.C. 121 "apparently (emphasis added) protects the applicant against the dangers" of double patenting that might have resulted from an improper restriction requirement. According to MPEP §803, the criteria for a proper restriction requirement are that the inventions are distinct and (emphasis added) there is a serious burden on the examiner. The GUIDELINES imply that the examiner should make a *prima facie* case of a "serious burden" and refer to MPEP §808.02.

MPEP §808.02 provides three reasons for an examiner to insist on restriction, namely, for the inventions at issue, there is a) separate classifications, or, if not, b) a separate status in the art, or, if not c) a different field of search is required, or some combination of these. The undersigned did not notice such a discussion. If it was not included, one might conclude that there would not be a serious burden on the examiner to examine both species on the merits. Therefore, it is respectfully requested that the examiner withdraw the restriction requirement and examine all claims.

If the examiner disagrees with the above conclusion, then it is respectfully requested that the examiner withdraw this restriction requirement and provide one that makes out a *prima facie* case of a serious burden on the examiner so that the applicants may have an opportunity to rebut it. In part, the reason for this insistence on following the Manual is that, while 35 U.S.C. 121 seems to insulate patents from invalidity for double patenting, the cases still require that Patent Office procedures are followed.

If the examiner believes this submission is not responsive to the examiner's mailing, it is respectfully requested that the examiner call the undersigned.

Respectively submitted,



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